

REMARKS

Claims 1-5, 7-12 are pending in the present application, claims 1, 8, and 10 having been amended and claim 6 having been cancelled without prejudice or disclaimer herein. The Office Action and cited references have been considered. Favorable reconsideration is respectfully requested.

Election/Restrictions

The Examiner required restriction of one of the following inventions:

- I. Claims 1-9, drawn to a device for counting fine particles, classified in class 359, subclass 398.
- II. Claims 10-12, drawn to a method of manufacturing a device for counting fine particles by a process comprising forming a mold, etching and pouring plastics, classified in class 264, subclass 155.

Applicants have amended claim 10 to be a dependent claim of independent claim

1. Accordingly, claims 11-12 are also dependent claims of claim 1 by virtual of their dependency from claim 10. Withdrawal of the Election/Restriction requirement is therefore respectfully requested.

Claim Rejection under 35 U.S.C. §103

Claims 1-9 were rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Patent No. 4,963,498 (“Hillman”) in view of U.S. Patent No. 1,693,961 (“Risch”). The rejection is respectfully traversed for the following reasons.

The present application is a device for counting fine particles. According to a non-limiting example embodiment shown in Figures 3, 4, 6 and 8 of the present application, a device includes a fill chamber 110 formed between an upper substrate 100 and a lower substrate 200. An area of the fill chamber 110 is transparent for microscopic observation and a fine lattice pattern 210 are formed on the lower substrate 200 in a predetermined place of the transparent area. The predetermined place is indicated by an indicative member 140 on the upper substrate 100. The example embodiment detects particles filled in the fill chamber, but not in a flowing state, by using the fine lattice patterns 210.

Hillman discloses or suggests a capillary flow device in Figures 2A and 2B of Hillman. The device includes a receiving chamber 58, a reaction chamber 60, and an effluent chamber 62. The three chambers are connected by capillary pathways 66 and 72 to flow a reagent from the receiving chamber 58 to the effluent chamber 62. For example, Hillman discloses that “[t]he device rely upon capillaries and other chambers to control movement of fluids” (Hillman, column 4, lines 54-56). Clearly, this device is used to detect a flow characteristic by using the structure character of the capillary pathway and to relate the flow characteristic to presence or amount of a fluid sample, i.e. Hillman detects particles in a flowing state.

Risch discloses or suggests a hemocytometer for counting blood cells. As shown in Figure 1 of Risch, the hemocytometer includes a glass body with rulings or gratings.

The Examiner alleges that because Hillman discloses three chambers and Risch discloses rulings on a glass body, combining Hillman and Risch would render the present application obvious. Applicants respectfully disagree.

Applicants submit that the Examiner has only provided a generic motivation for combining Hillman and Risch in order to assert the obviousness of claim 1. Applicants submit that alleging that one skilled in the art would have been motivated to make the proposed combination of references without providing any evidence of the justification for doing so, would effectively remove any need for some technical or logical motivation absent guidance provided by the present Specification for making the combination. See MPEP § 2143.01; citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination). "[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 167 L. Ed. 2d 705 (2007) ("To facilitate review, this analysis should be made explicit.") (citing *Kahn*, 441 F.3d at 988).

Because Hillman detects particles by using a detecting method different from the counting method of the present application, Hillman does not need a grid pattern for counting particles. One of ordinary in the art would understand that for a method of counting cells through microscopy, it would be difficult to locate the fine patterns in the fill chamber of Hillman. Therefore, one of ordinary in the art would not have a motivation to combine Hillman and Risch.

Accordingly, unless and until the Examiner provides objective evidence and/or makes specific factual findings with respect to the motivation to combine references, *In re Lee*,

277 F.3d 1338, 1342-44 (Fed. Cir. 2002), Applicants maintain that any proposed combination remains improper and should be withdrawn.

For at least these reasons, Applicant respectfully submits that claim 1 is allowable. Claims 2-9 are also allowable by virtue of their dependency from claim 1 and features recited therein. Withdrawal of the rejection under 35 U.S.C. §103 is therefore respectfully requested.

Conclusion

For at least these reasons, Applicant respectfully submits that claims 1-12 are patentable over the prior art of record whether taken alone or in combination as proposed in the Office Action.

In view of the above amendment and remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of record. Applicant submits that the application is in condition for allowance and early notice to this effect is most earnestly solicited.

If the Examiner has any questions, he is invited to contact the undersigned at 202-628-5197.

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Respectfully submitted,

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